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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,192	12/04/2003	Curt L. Cotner	SVL920030122US1/2991P	2148
7590	10/04/2006			EXAMINER
SAWYER LAW GROUP LLP			MORRISON, JAY A	
P.O. Box 51418			ART UNIT	PAPER NUMBER
Palo Alto, CA 94303				

2168

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/730,192	COTNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jay A. Morrison	2168	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 December 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  - 1. Certified copies of the priority documents have been received.
  - 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.                                     |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/4/03</u> .   | 6) <input type="checkbox"/> Other: _____.                         |

## **DETAILED ACTION**

1. Claims 1-15 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims do not recite a practical application by producing a physical transformation or producing a useful, concrete, and tangible result. To perform a physical transformation, the claimed invention must transform an article or physical object into a different state or thing. Transformation of data is not a physical transformation. A useful, concrete, and tangible result must be either specifically recited in the claim or flow inherently therefrom. To be useful the claimed invention must establish a specific, substantial, and credible utility. To be concrete the claimed invention must be able to produce the same results given the same initial starting conditions. To be tangible the claimed invention must produce a practical application or real world result. In this case the claims fail to perform a physical transformation because the claims are directed to operating on data. The claims are useful and concrete, but they fail to produce a tangible result because no result is stored to non-volatile media or, for example, reported to a user.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1,5-6,11,15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the appropriate package" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the database server system" in line 1. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination it will be assumed the Applicant meant "the database system".

Claim 6 recites the limitation "the appropriate package" in lines 6-7. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the appropriate package" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the database server system" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim. For purposes of examination it will be assumed the Applicant meant "the database system".

***Claim Rejections - 35 USC § 102***

Art Unit: 2168

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,5-6,11,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chamberlain et al. ('Chamberlain' hereinafter) (Patent Number 6,317,880).

As per claim 1, Chamberlain teaches

A method for providing package resolution in a database system comprising:  
(see abstract and background)  
providing a statement within a server which allows an application to identify a list of package collections; (list of versions, column 14, lines 53-64)  
and executing the statement to obtain the appropriate package. (retrieves appropriate file, column 15, lines 5-15)

As per claim 5, Chamberlain teaches

the database server system is a distributed server system. (column 6, lines 50-61)

As per claim 6, Chamberlain teaches

A database server system comprising: (see abstract and background)

a database; (installer registry column 14, lines 43-45)  
a catalog containing a list of packages; (list of versions, column 14, lines 53-64)  
and a server coupled to the database and the catalog; (column 14, lines 43-64)  
the server including a statement which allows an application to identify a list of  
package collections and for executing the statement to obtain the appropriate package.  
(retrieves appropriate file, column 15, lines 5-15)

As per claim 11, Chamberlain teaches

A computer readable medium containing program instructions for providing  
package resolution in a database system, the program instructions for: (see abstract  
and background)

providing a statement within a server which allows an application to identify a list  
of package collections; (list of versions, column 14, lines 53-64)  
and executing the statement to obtain the appropriate package. (retrieves  
appropriate file, column 15, lines 5-15)

As per claim 15, Chamberlain teaches

the database server system is a distributed server system. (column 6, lines 50-  
61)

Art Unit: 2168

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 2-4,7-10,12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain et al. ('Chamberlain' hereinafter) (Patent Number 6,317,880).

As per claim 2,

Chamberlain does not expressly show "the statement comprising a SET CURRENT PACKAGE PATH statement".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. This data is in no way

made functional in the claim. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to "the statement comprising a SET CURRENT PACKAGE PATH statement" because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 3,

Chamberlain does not expressly show "the list of package collections include a combination of literals, host variables, keywords and null string".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. This data is in no way made functional in the claim. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to "the list of package collections include a combination of literals, host variables, keywords and null string" because such data

does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claim 4,

Chamberlain does not expressly show "each package includes a collection ID and a package ID".

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. This data is in no way made functional in the claim. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to "each package includes a collection ID and a package ID" because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

As per claims 7-9,

These claims are rejected on grounds corresponding to the arguments given above for rejected claims 2-4 and are similarly rejected.

As per claim 10, Chamberlain teaches  
the database server system is a distributed server system. (column 6, lines 50-  
61)

As per claims 12-14,  
These claims are rejected on grounds corresponding to the arguments given  
above for rejected claims 2-4 and are similarly rejected.

***Conclusion***

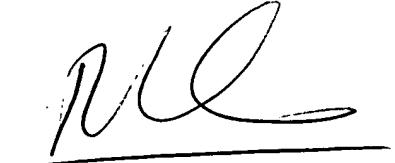
The prior art made of record, listed on form PTO-892, and not relied upon is  
considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-  
7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the  
organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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7/29/06